UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,174	10/30/2003	Howard Shelton Lambert	GB920020091US1	2506

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EXAMINER
LASHLEY, LAUREL L

ART UNIT	PAPER NUMBER
2132	

NOTIFICATION DATE	DELIVERY MODE
01/25/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)
	10/698,174	LAMBERT ET AL.
	Examiner	Art Unit	
	Laurel Lashley	2132	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>31 October 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   Applicant's claim amendments , specifically claims 12 and 17-18 filed 10/31/2007 have

been accepted and entered. Claims 1 - 18 are still pending.

2.   The rejection under 35 USC 101 has been overcome and is therefore withdrawn.

Response to Arguments

3.   Applicant's arguments filed 10/31/2007 have been fully considered but they are not

persuasive. It is Applicant's assertion that the proposed combination, considered as a whole,

does not teach the features of, "means, responsive to successful authentication, for decrypting

a user specific table associated with the user, wherein the user specific table identifies the set,"

as required by claim 1.

Specifically, Applicant argues *Holvey* simply *does not* state or imply that the information

is in the form of a user specific table and *Holvey* gives no hint or suggestion that the information

should be stored in a user specific table. The Examiner

As for Prihoda, Applicant argues that the reference does not decrypt a *user specific table*

but rather teaches the opposite - a *centralized database.*

In response to applicant's argument that there is no suggestion to combine the

references, the examiner recognizes that obviousness can only be established by combining or

modifying the teachings of the prior art to produce the claimed invention where there is some

teaching, suggestion, or motivation to do so found either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071,

5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

1992).

In this case, Holvey is concerned with protecting sensitive information, such as a user's

personal information stored in database. Holvey illustrates a table which identifies the set of

stored data available to each authorized user (see [0023]-[0024]: Table 1). Based on the

broadest reasonable interpretation of Applicant's claim language, the Examiner equates

Holvey's teaching of Table 1, which summarizes the access rights of each type of user in

relation to data (i.e. patient medical records) to Applicant's user specific table. Holvey

establishes the teaching of a user specific table but does not disclose that the data within the

table being cryptographically processed or decrypted as Applicant's claim limitation requires. To

cure this deficiency in Holvey, the Examiner relies on Prihoda's recitation of data within a

database being decrypted/encrypted by authorized users (see column 1, lines 57-65,

storage...database...data...decrypted). The recitation of Prihoda's central database is still

capable of performing the intended use of Applicant's claim language (i.e. decrypting data in the

database by an authorized user), thus satisfying the claim limitation. Therefore, Holvey's

establishment of a user specific table is combined with Prihoda's teaching of decrypting data

within a database (i.e. user specific table). Encrypting data is has been well-known since long

before the invention. Therefore, it would have been obvious to one of ordinary skill in the art at

the time of the invention to modify the user specific table of Holvey to encrypt and decrypt data

as taught by Prihoda in order to maintain confidentiality of users' information.

It is Applicant's further assertion that "Holvey and Prihoda teach away from the invention

of Claim 1". Again the Examiner respectfully disagrees.

In response to applicant's argument that the examiner's conclusion of obviousness is

based upon improper hindsight reasoning, it must be recognized that any judgment on

obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

long as it takes into account only knowledge which was within the level of ordinary skill at the

time the claimed invention was made, and does not include knowledge gleaned only from the

applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392,

170 USPQ 209 (CCPA 1971).

For at least these reasons the Examiner maintains rejection of claims 1 -18.

Claim Rejections - 35 USC § 103

4.   **Claims 1-8 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable**

over Holvey et al., U.S. Patent Publication No. 2004/0054935, (hereinafter "Holvey"), in

view of Prihoda et al., U.S. Patent No. 6,789,195, (hereinafter "Prihoda").

5.   **Regarding claims 1, 11 and 12:** Holvey discloses a data processing system (Title),

method (Title), and an executable computer program on a tangible medium ([0038] software),

respectively, for controlling access of at least one user to stored data comprising:

means, responsive to a request from the user to access a set of the stored data that is

available to the at least one user, for authenticating the user ([0022] requesting user

authenticated via voice-print or ID and password); and

a user specific table associated with the user (patient medical records and associated

authorized users), wherein the user specific table identifies the set ([0023]-[0024] Table 1).

Holvey does not disclose decrypting the user specific table or accessing the set in

response to successful decryption.

Prihoda discloses means, responsive to successful authentication, for decrypting a user

specific table associated with the user (col. 1, ll. 57-65, storage...data...decrypted...); and

means, responsive to successful decryption, for accessing the set (col. 2, ll. 15-20,

authorized data access with key...).

As one of ordinary skill in the art at the time of the invention would know, encrypting

documents has been well-known since long before the invention. Therefore, it would have been

obvious to one of ordinary skill in the art at the time of the invention to modify Holvey by

encrypting and decrypting data as taught by Prihoda in order to maintain confidentiality of users'

information. (see Prihoda, col. 2 ll. 15-16).

Regarding claim 2: Holvey discloses that the user specific table comprises data

associated with the location of the set ([0032] hyperlinks).

Regarding claim 3: Holvey does not disclose that the set is encrypted or that the user

specific table comprises data associated with decryption of the set.

Prihoda discloses that the set is encrypted and the user specific table comprises data

associated with decryption of the set (col. 2, ll. 15-20, special key for decrypting).

Encrypting documents has been well-known since long before the invention, therefore, it

would have been obvious to one of ordinary skill in the art at the time of the invention to modify

Holvey by encrypting and decrypting data as taught by Prihoda in order to maintain

confidentiality of users' information, (see Prihoda, col. 2 ll. 15-16).

Regarding claim 4: Holvey discloses a set comprising all of the stored data ([0023]

complete set of rights).

Regarding claim 5: Holvey discloses a set comprising portion of the stored data ([0023]

limited rights).

Regarding claim 6: Holvey discloses a request initiated by presentation of a token by

the user ([0022] token).

Regarding claim 7: Holvey discloses a token comprising means associated with an

identity of the user ([0022] user specific token).

Regarding claim 8: Holvey discloses a means associated with the identity of the user derived from one or more biometric characteristics associated with the user ([0022] and [0031] voice-print).

Regarding claim 10: Holvey discloses stored data capable of access by more than one user ([0023] owners/patients and other authorized users), and means for accessing data associated with each user of the more than one users ([0023] patients have complete access, other authorized users' access is controlled by patients).

6.   **Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Holvey and Prihoda as applied to claim 1 above, and further in view of Chadwick, "Smart Cards Aren't Always the Smart Choice," IEEE Computer, December 1999, v. 32, issue 12, pp. 142-143, (hereinafter "Chadwick").**

7.   **Regarding claim 9:** Holvey discloses a token ([0022]). Holvey does not disclose the token comprising the means for decrypting. Prihoda discloses a token comprising the means for decrypting (Abstract and col. 2, ll. 15-20, key for decrypting).

As one of ordinary skill in the art at the time of the invention would know, software tokens have been well-known since long before the invention, (see Chadwick, p. 142, col. 1-2, regarding public/private key infrastructure software tokens). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Holvey by encrypting and decrypting data as taught by Prihoda in order to maintain confidentiality of users' information, (see Prihoda, col. 3 ll. 20-21).

8.   **Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Holvey and Prihoda as applied to claim 1 above, and further in view of Mita et al., U.S. Patent Publication No. 2002/0035485 A1, (hereinafter "Mita").**

9.   **Regarding claims 13, 15 and 17:** Holvey discloses additional user specific tables for

each additional user ([0007] patient database, i.e., collection of patient tables).

Mita discloses means for attempting to decrypt, in turn, each of the user specific tables

until a successful decryption occurs ([0042] sequential search).

As one of ordinary skill in the art at the time of the invention would know, sequential

searching has been well-known since long before the invention. Therefore, it would have been

obvious to one of ordinary skill in the art at the time of the invention to modify Holvey by

sequential searching as taught by Mita in order to access stored personal including medical

data (*see* Mita, Title).

Regarding claims 14, 16, and 18: Holvey discloses that the user specific table

comprises data associated with the location of the set ([0032] hyperlinks).

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. Brown et al. in US Patent No. 5941947 discloses a system and method for

controlling access to data entities in a computer network.

11.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as

set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurel Lashley whose telephone number is 571-272-0693. The examiner can normally be reached on Monday - Thursday, alt Fridays btw 7:30 am & 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron, Jr. can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Laurel Lashley
Examiner
Art Unit 2132

7 January 2008
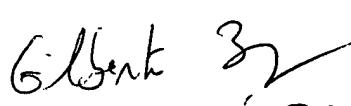
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